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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,697	05/24/2004	Kenneth William Austin	03292.101850	3696
66569 7590 01/16/2008 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER TROTTER, SCOTT S	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 01/16/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/709,697

Applicant(s)

AUSTIN ET AL.

Examiner

Scott S. Trotter

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the application submitted May 24, 2004. No amendments to the application have been received as of this office action. No priority claim appears in the file as of this office action.

#### ***Information Disclosure Statement***

2. No IDS has been received as of the instant Office action.

#### ***Claim Rejections - 35 USC § 101 Utility***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Modules could be simply software modules which would be a software claim which is not statutory.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4, 5 and 7, and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Sartor et al. (U.S. PG Pub. 2002/0161711 A1 hereafter Sartor).

As per claim 1 Sartor teaches:

A method for facilitating the processing of requests for an item, comprising:  
receiving a communication from a caller, (*See Sartor Abstract*) the communication including a request for said item; (*See Sartor Abstract*)  
obtaining information from the customer for use in processing the request;  
evaluating a first set of criteria related to the information to determine if the request involves potential fraud; (*See Sartor Abstract*. The type of item being purchased such as a gift card being more likely to involve fraud.)  
selectively evaluating, based upon the evaluation of the first set of criteria, a second set of criteria related to the information to determine if the request involves potential fraud; (*See Sartor Abstract*.) and outputting an indication of the evaluating step and using the indication to determine whether to issue the requested item. (*See Sartor Abstract*)

As per claim 2 Sartor teaches:

The method of claim 1, wherein said step of receiving a communication from a customer includes receiving a communication from a customer wherein said item is at least one of a good, service, transaction, financial account and financial card. (*See Sartor Abstract*. Standard physical products are goods.)

As per claim 4 Sartor teaches:

The method of claim 1, further including evaluating override criteria related to the customer for use in determining whether to issue the requested item. (*See Sartor*

*Figures 2 and 3.* The evaluation criteria include many customer specific criteria to determine whether to allow the transaction to go through.)

As per claim 5 Sartor teaches:

The method of claim 1, further including using the outputted indication to determine whether to authorize a transaction requested by the caller. (See *Sartor Figure 1*. Allowing the event (112) is authorizing the transaction.)

As per claims 7, 9 and 11 they contains no new limitation not directed to intended use which are considered nonfunctional under MPEP 2106.(II.C) since no new functional limitations are introduced it is rejected as claims 1, 5, and 4 above. The only difference is the kind of item being requested which is a nonfunctional limitation.

As per claim 10 approving a transaction would be opening a transaction card account.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sartor in view of Official Notice.

As per claim 3 Sartor teaches:

The method of claim 1 wherein the evaluating the first set of criteria step includes at least one of evaluating information from an automatic number identification service and information from a password provided by the caller.

While Sartor does not explicitly teach evaluating if the caller id of the caller and a password cause a different set of rules to be picked. It is old and well known in the art of fraud detection to use caller id to verify if a caller is calling from the number claimed used by most restaurants accepting phone orders at least since the mid-nineties. It is also old and well known in the art of fraud detection to use a password to confirm someone's identity with the most common example being a debit card pin code. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust their concern level and use different rules to allow a transaction regarding potential fraud based on if caller tended to confirm or deny a caller's identity and whether a caller supplied a confirmable password such as a debit card's pin code to substantiate their identity.

As per claim 8 it contains no new limitation not directed to intended use which are considered nonfunctional under MPEP 2106.(II.C) since no new functional limitations are introduced it is rejected as claims 3 above. The only difference is the kind of item being requested which is a nonfunctional limitation.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palaghita et al. (U.S.PG Pub. 2004/0064401 A1) in view of Sartor.

As per claim 6 Palaghita teaches:

An apparatus for facilitating the processing of requests for financial-related transactions, comprising:

- a module configured to receive, via a communications network, a communication from a caller, the communication including a request for a particular financial card; (See *Palaghita paragraphs 35 and 4*. The Database receives the documents which are associated with a credit card application.)

- a module configured to obtain information from the customer for use in processing the request; (See *Palaghita paragraphs 35*)

- a module configured to evaluate a first set of criteria related to the information to determine if the request involves potential fraud;

- a module configured to selectively evaluate, based upon the evaluation of the first set of criteria,

- a second set of criteria related to the information to determine if the request involves potential fraud; and

- a module configured to output, via a network, an indication of the evaluating and using the indication to determine whether to issue the requested financial card.

While *Palaghita* does not explicitly include detecting fraud using the method taught in *Sartor* it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate *Sartor* to take advantage of different criteria that changed the likelihood of fraud occurring in a particular case. Such as an application made by an account holder in good standing made in person with an

identification check at a branch office versus an application made over a website to a non-account holder.

### **Conclusion**

10. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. Any inquiry concerning this communication from the examiner should be directed to Scott S. Trotter, whose telephone number is 571-272-7366. The examiner can normally be reached on 8:30 AM – 5:00 PM, M-F.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. The fax phone number for the organization where this application or proceeding is assigned are as follows:



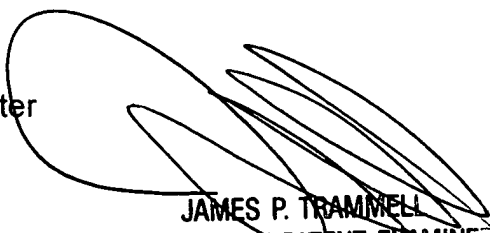
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(571) 273-8300 (Official Communications; including After Final  
Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

Scott Trotter  
1/6/2008



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600